

REMARKS

I. Status of the Claims

Claims 2-8 and 32-77 are pending in the application. No claim is amended by this response.

II. Rejections Under 35 U.S.C. § 103(a)

Rondeau et al. in view of Saphakkul

Claims 2-8, 32-50, 54-57, and 61-77 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rondeau et al.* [US 6,001,135] in view of *Saphakkul* [EP 0,312,343] for reasons of record and for the reasons set forth at page 2 of the Advisory Action. Applicants respectfully traverse this rejection.

In the Advisory Action, the Examiner concludes that "a prima facie case has been established" because:

- "*Rondeau*...discloses that in order to vary the shades obtained further and to give them glints, it is possible to use, in combination with the oxidation dye precursors and the coupler, direct dyes, that is to say colored substances which provide coloration in the absence of an oxidizing agent;" see page 2 of the Advisory Action;

- "*Rondeau* teaches that the dyeing composition...can also contain other direct dyes in particular in order to modify the shade or to enrich them with glints...and quaternary polyammonium compound;" *id.*; and

- "*Saphakkul* teaches a product for conditioning and dyeing hair comprising cationic surfactants, includ[ing] quaternary ammonium salts and direct dyes." *Id.*

In order to establish a *prima facie* case of obviousness, the Examiner must show (1) that all claim elements are disclosed by the prior art references, (2) that there exists some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings, and (3) that there is a reasonable expectation of success. See M.P.E.P. § 2143. Further, references cannot be combined where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983). Here, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness, for at least the reason that he has not shown the existence of any suggestion or motivation to combine the teachings of the cited references.

Specifically, the Federal Circuit has held that “[p]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir, 2000) (emphasis added). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the issue in question is not whether the prior art could be modified, but whether there was the requisite suggestion to do so. In the present case, the Examiner has pointed to no such suggestion in the cited art.

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The present claims recite, *inter alia*, a composition comprising (i) at least one cationic direct dye of formulas (I) - (IV) and (ii) at least one quaternary ammonium salt of formulas (V) -(VII). As admitted by the Examiner, *Rondeau* does not teach or suggest the claimed quaternary ammonium salts. *Saphakkul* teaches a product for conditioning and gradually dyeing hair using a combination of basic and neutral direct dyes, a C₈-C₂₂ fatty alcohol, and a cationic surfactant, including quaternary ammonium salts, in the form of a disperse lamellar liquid crystal phase. See page 2, lines 44-63. Thus, *Rondeau* teaches an oxidation dyeing composition containing oxidative dyes and direct dyes but does not teach or suggest the use of the claimed quaternary ammonium salts. *Saphakkul* teaches a direct dyeing composition containing direct dyes and quaternary ammonium salts but which specifically does not contain oxidative hair dyes and does not teach or suggest the use of the quaternary ammonium salts disclosed therein alone (in the form of liquid crystals or not) or in combination with any other dye composition, let alone *Rondeau*'s compositions comprising at least one oxidation base in combination with at least one oxidizing agent and at least one selected cationic direct dye.

Second, Applicants submit that *Saphakkul* teaches away from combination with oxidation dyes. References cannot be combined where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983). A prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied,

469 U.S. 469 U.S. 851 (1984) (emphasis added). *Saphakkul* teaches away from the use of oxidative dyes for two reasons: first, according to *Saphakkul*, "the consumer usually prefers a gradual darkening treatment, so that the return to the original shade is not dramatic and therefore not noticeable to [a] casual observer." *Id.*; and second, when stronger dyes are employed, undesirable hand staining occurs. See page 2, line 29. To produce a gradual dyeing, *Saphakkul* utilizes a mixture of basic and neutral direct dyes with quaternary ammonium salts typically applied 10 times. See page 2, line 35 and page 6, line 1. Thus, in the present case, *Saphakkul* teaches away from the use of, and therefore combination with, oxidation dyes, and therefore teaches away from combination with the compositions of *Rondeau*.

Despite Applicants' explanation of their position above and of record, the Examiner has maintained the rejections without any real explanation as to why he thinks the references suggest their combination to one of ordinary skill in the art. The M.P.E.P. instructs an Examiner to take note of Applicants' arguments and answer the substance of them. See M.P.E.P. § 707.07(f). The Examiner has failed to do so here.

Further, the Federal Circuit has recently emphasized that "[t]he factual inquiry whether to combine references must be thorough and searching. It **must be based on objective evidence of record**.... Thus the [PTO] must not only assure that the requisite findings are made, based on evidence of record, but **must also explain the reasoning** by which the findings are deemed to support the agency's conclusion." See

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In re Lee, 277 F.3d 1338, 1342 (Fed. Cir. 2002) (emphasis added). The Examiner has failed to meet this requirement as well.

In fact, and as argued above, in the present case, the objective evidence of record does **not** suggest the desirability of the proposed combination. The reference teachings do not overlap and in fact teach away from each other. Yet, the Examiner merely continues to recite the components of the references' compositions and summarily conclude that a *prima facie* case of obviousness has been established.. Therefore, Applicants expressly request that, should the Examiner maintain this rejection, he clearly and specifically "explain the reasoning by which the findings are deemed to support [his] conclusion of obviousness." *Id.*

Applicants maintain there was not for at least the following reasons.

For at least the reasons set forth above, a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request that this rejection under § 103(a) be withdrawn.

Rondeau et al. in view of Saphakkul in further view of Aaslyng et al.

Claims 51-53 and 58-60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rondeau et al.* in view of *Saphakkul* in further view of *Aaslyng et al.* [WO 9719998] for reasons of record and for the reasons set forth at page 2 of the Advisory Action. Applicants respectfully traverse this rejection for at least the following reasons.

Rondeau and *Saphakkul* are discussed above. As the Examiner merely relies on *Aaslyng et al.* for its disclosure of couplers (pages 6-7) and of oxidation enzymes such as laccase (page 4, lines 30-34), *Aaslyng et al* does not disclose anything which would have provided the missing motivation to combine *Rondeau* and *Saphakkul*. Therefore, for the reasons set forth above, this rejection under § 103(a) is improper and should be withdrawn.

CONCLUSION

In view of the foregoing, Applicants respectfully request continued examination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to deposit account 06-0916.

Respectfully submitted,
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